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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,934	11/25/2003	Rita Bitzer	10537/171A	9401
26646 7590 02/22/2007 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			EXAMINER GREEN, ANTHONY J	
			ART UNIT 1755	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/723,934

Applicant(s)

BITZER ET AL.

Examiner

Anthony J. Green

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-10, 12-17, 27 and 31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-10, 12-17, 27 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment submitted on 26 December 2006. Claims 2-10, 12-17, 27 and 31 are currently pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2-10, 12-17, 27 and 31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant argues that the claims are enabled as one of ordinary skill in the art would know how to make and/or use the invention without undue experimentation and that the size of roughness, average pore diameter and score marks was known. because one skilled in the art of brake lacquers or brake coating compositions would understand what was meant by an "average grain size that is substantially equal to at least one of a maximum roughness and an average grain size of score marks of the braking surface" and "average pore diameter" because applicant has amended the

claims to clarify that the composition is for a braking surface as the instant claims now recite in the preamble "corrosion protective brake lacquer".

To these arguments the examiner respectfully disagrees as it is unclear as to the types of brakes encompassed by the claims (i.e. automobile, heavy machinery, trucks etc.) and it is unclear as to whether or not the composition is for application to new brakes or brakes that have been already used or are under use as the average grain size that is substantially equal to at least one of a maximum roughness, an average pore diameter and an average grain size of score marks of the braking surface would depend on the type of brake, its conditions of use etc. and therefore it would require undue experimentation to determine what the average grain size of the protective substance is supposed to be. Applicant's arguments are based on unrecited comparisons. The specification provides no guidance as to the grain size of the protective substances used that are within the scope of the invention. Applicant is claiming a composition by its properties which renders the claims not enabled as the exact grain size of the composition would depend on the average grain size of the particular braking system utilized and when it is applied to the braking system (i.e. to brand new brakes, brakes that are slightly worn etc.) and would require undue experimentation to determine the scope of the claim. One cannot determine what size is within the scope of the claim and therefore one cannot ascertain what grain size would infringe on the instant claim and accordingly an accurate comparison of the prior art with the instant claims cannot be performed.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2-10, 12-17, 27 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the independent claims it is unclear as to the grain size encompassed by the phrase "substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks". Applicant argues that the claims are not indefinite as the size of roughness, average pore diameter and average score marks on a braking surface of a brake disk and brake drum was known to one of ordinary skill in the art at the time of the filing of the application.

To this argument the examiner respectfully disagrees. The claim is drawn to a composition and is not clear as to the type of brake encompassed by the claim. Applicant should refer to the 112 first paragraph rejection for more details. Further it should be noted that "An article characterized by physical properties alone and no specific composition is vague and indefinite". See Ex parte Slob 157 USPQ 172.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 2-4, 10, 12-14, 17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by German Patent Specification No. DE 4314432 for the reasons set forth in the previous office action and which are herein incorporated by reference.

The instant claims are met by the reference. It is the position of the examiner that the inorganic zinc compound meets applicants protective substance that reacts with oxygen. Note page 2 of the reference, lines 46-47, which recite the types of inorganic zinc compounds utilized. With respect to claim 27 while the reference does not recite that the lacquer is non-tinted or tinted, it is the position of the examiner that it would have to be one or the other as lacquers are either clear or tinted absent evidence to the contrary. Furthermore it is believed that the presence of the zinc compound would tint the lacquer absent evidence showing otherwise. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size especially since the composition of the reference is used for the same purpose. Thus the instant claims are met by the reference.

Applicant argues that the reference does not disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of

average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining during braking, as required by claim 31. Further the examiner must provide a reference that the Examiner that discloses a protective substance within the recited size range.

To these arguments the examiner respectfully disagrees as it is the position of the examiner that the grain size of the reference is inherently one that is substantially equal to at least one of a maximum roughness, average pore diameter, and average size of score marks as the composition is used for the same purpose and applicant has not provided any evidence showing that the average grain size of the reference does not meet these limitations particularly in view of the fact that the instant claims do not recite a specific size that is intended to be encompassed by the claim limitation.

8. Claims 2-7, 10, 12-17, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Specification No. 976,795 for the reasons set forth in the previous office action and which are herein incorporated by reference.

The reference leaches, in the abstract, the examples and the claims, an antifriction coating comprising a lubricant, corrosion inhibitor and solvent. The composition may be used to treat brake rotors and drums (abstract).

The instant claims are met by the reference. It is the position of the examiner that the coating of the reference can broadly be considered to be a "lacquer" absent evidence to the contrary as one definition of the term "lacquer" is known in the art to represent "any of various clear or colored synthetic organic coatings that typically dry to

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form a film by evaporation of the solvent" (a copy of this definition was included in a previous office action). The corrosion inhibitor is selected from aluminum particles, zinc particles and a metal phosphate which meets the protective substance of instant claims 2-3 and 11-13. As for the amount of protective substance (instant claims 4-6 and 14-16) the claims recite that the amount ranges from 40 to 65% (with the solvent (i.e. claim 5 of the reference)) or 70-80% after curing (i.e. without the solvent (claim 9 of the reference)). As for claim 27 the examples teach the addition of pigments thus meeting this claim. As for the grain size, it is the position of the examiner that absent evidence showing otherwise the grain size of the reference meets the instantly claimed grain size especially since the composition of the reference is used for the same purpose. Thus the instant claims are met by the reference.

Applicant argues that the reference does not disclose, or even suggest, a protective substance having an average grain size that is substantially equal to at least one of a maximum roughness and an average size of score marks of a braking surface of at least one of a brake disk and a brake drum, as required by claim 10, a protective substance having an average grain size substantially equal to at least one of a maximum roughness, an average pore diameter and an average size of score marks of the braking surface of the at least one of the brake disk and the brake drum, as required by claim 17, and a protective substance configured to fill one of a pore and a score of average size on the braking surface of the at least one of the brake disk and the brake drum upon abrading the corrosion protective coating composition by a brake lining

during braking, as required by claim 31. Further the examiner must provide a reference that the Examiner that discloses a protective substance within the recited size range.

To these arguments the examiner respectfully disagrees as it is the position of the examiner that the grain size of the reference is inherently one that is substantially equal to at least one of a maximum roughness, average pore diameter, and average size of score marks as the composition is used for the same purpose and applicant has not provided any evidence showing that the average grain size of the reference does not meet these limitations particularly in view of the fact that the instant claims do not recite a specific size that is intended to be encompassed by the claim limitation.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony J. Green whose telephone number is 571-272-1367. The examiner can normally be reached on Monday-Thursday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on 571-272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Anthony J. Green
Primary Examiner
Art Unit 1755

ajg
February 12, 2007